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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,151	06/16/2005	Ulrich Berens	VT/95-22814/A/PCT	2741
324	7590	04/30/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			NOLAN, JASON MICHAEL	
			ART UNIT	PAPER NUMBER
			1626	
			NOTIFICATION DATE	DELIVERY MODE
			04/30/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/539,151	<b>Applicant(s)</b> BERENS ET AL.	
	<b>Examiner</b> JASON NOLAN	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21, 22, 24, 31-36, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32, 36, 41 and 42 is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 21, 22, 24, 31 and 33-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is responsive to Applicant's Amendment After-Final, filed 04/03/09. As presented, Claims 18, 19, 21, 22, 24, 31-36, 41, & 42 are pending. Claims 1-17, 20, 23, 25-30, 37-40, & 43 are cancelled. Previously, in the Office Action, mailed 02/04/2009, Claims 19, 21, 22, 24, & 31-35 were deemed allowable subject matter. Due to the difficulties arising from a translation of a foreign application, amendments to the claims are necessary for allowance. As such, the allowability of said claims and the finality of that office action are withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 & 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 18, the phrase "of pharmaceuticals or" should be deleted because it renders the claim indefinite. The claim is drawn a method for the synthesis of a compound of formula (II) via the reaction between formula (III) and formula (V), and the preamble should reflect this. A method for manufacturing pharmaceutical compositions represents a different searchable class, a distinct inventive concept, and implies further steps; and, thus, should be in a separate claim.

Further, the phrase at the end of the claim, "and further comprising reducing the indolone moiety in compound of the formula II in the presence of a complex hydride" is contradictory to the preamble, which is drawn to making formula II. Claim 19 is directed to the reduction of formula II to produce formula (XII), which appears to be what the phrase at the end of Claim 18 is conveying. As such, there are two solutions: either Claim 18 can be amended to include the scope of Claim 19, and amended to have the preamble reflect a process for the synthesis of formula (XII); or, alternatively, the phrase at the end of Claim 18, identified supra, should be deleted and the preamble of Claim 19 should be amended with language, for example, "The method according to Claim 18, further comprising . . ."

### ***Claim Objections***

Claim 24 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In this case, an amendment would be proper.

Claim 24 is drawn to a method according to Claim 22 wherein either formula (XIV) or formula (XII) is subsequently reacted. Claim 24 is dependent on Claim 22, which is dependent on Claim 21, which is dependent on Claim 18. Formula (XII) does not arise in Claim 18, but in Claim 19. For this reason, Claim 24 lacks proper dependency for formula (XII).

Claims 18, 19, 21-22, 24, 31, & 33-35 are objected to because of the following informalities: Said claims lack proper preambles and consistency. Specifically, Claims 18, 19, 21, & 24 are drawn to a "method" and Claims 22, 31, & 33-35 are drawn to a "process." To be consistent, all claims should be identified as either a method or a process. Further, the independent claims should recite, for example, "A method" and dependant claims should recite "The method according to . . ." Appropriate correction is required.

#### ***Allowable Subject Matter***

Claims 32, 36, 41, & 42, drawn to compounds, are allowed.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Nolan whose telephone number is (571) 272-4356 and e-mail is [Jason.Nolan@uspto.gov](mailto:Jason.Nolan@uspto.gov). The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on (571) 272-0699. The USPTO fax number for applications is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, (either Private PAIR or Public PAIR). Status information for unpublished applications is available through Private PAIR only. For more information

Art Unit: 1626

about the PAIR system, see <http://pair-direct.uspto.gov>. For questions on Private PAIR system, contact the Electronic Business Center at (866) 217-9197.

/Jason M. Nolan/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626